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The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING

2 UNITED STATES PATENT AND TRADEMARK OFFICE

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5 BEFORE THE BOARD OF PATENT APPEALS
6 AND INTERFERENCES
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10 Ex parte TAKASHI MIYAKAWA and
11 SATORU INOUE
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14 Appeal 2008-4337
15 Application 10/717,502
16 Technology Center 1700
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19 Oral Hearing Held: Wednesday, November 5, 2008
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22 Before BRADLEY R. GARRIS, ROMULO H. DELMENDO, and
23 JEFFREY T. SMITH, Administrative Patent Judges
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26 ON BEHALF OF THE APPELLANT:
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28 DANIEL TANNER, ESQ.
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1 The above-entitled matter came on for hearing on Wednesday,
2 November 5, 2008, commencing at approximately 9:55 a.m., at the U.S.
3 Patent and Trademark Office, 600 Dulany Street, 9th Floor, Alexandria,
4 Virginia, before Laurie Allen, Notary Public.

5 JUDGE GARRIS: Good morning, Mr. Tanner.

6 MR. TANNER: Good morning, Your Honor. How are you?

7 JUDGE GARRIS: Very well, thank you.

8 Mr. Tanner, as you know, you have about 20 minutes to present
9 your case. Please begin.

10 MR. TANNER: Well, again, good morning, Your Honor. May
11 it please the board, I am Dan Tanner, and I'm here to briefly discuss this
12 morning a process for the production of a honeycomb body. As you
13 understand from my papers, we believe that there are several errors in the
14 final rejection, and I'd like to speak briefly to several of those this morning.
15 Our remarks are going to be primarily directed to the patentability of claim
16 1, but that's not to imply that we believe that the claims stand and fall
17 together. There are appropriate arguments made to several of the dependent
18 claims in our papers that we're going to go ahead and rely on.

19 Claim 1 recites, among other features, adding a predetermined
20 amount to the raw material for forming -- for forming a honeycomb body, a
21 powdery material that's made from crushing into maximum particulate
22 diameter of 50 millimeters a crushed green body. So, this is a reclaimed
23 material.

24 It's important to note that the crushed body is obtained from a
25 rejected product of an undried formed material, and therein lies a significant
26 distinction over what has -- what has been found in the prior art.

1 There have been no problems, or limited problems, in the prior
2 art of mixing dry and dry materials, and that's going to become important to
3 the following discussion. However, when you mix undried materials with
4 these dry materials, you end up creating these fist-like clumps that require
5 significant further processing.

6 Now, the rejection rejects the pending claims over a
7 combination of an Asami reference, which is owned by the same patent
8 owner as the current application, and a Japanese reference which is to
9 ceramic bodies and wet ceramic materials.

10 The final rejection concedes that the Asami reference doesn't
11 teach undried reclaimed materials being added to raw ceramic material, but
12 it goes on to state that at least there is some basis in one embodiment of the
13 Asami reference that, well, it doesn't necessarily have to be dry, and
14 therefore, the final rejection uses that presumption or that conclusion as a
15 stepping off point for then combining with the Japanese reference to go dry
16 and dry, wet and wet -- and I'm not trying to -- to demean this at all, but it
17 doesn't -- when it says dry and dry or wet and wet, it doesn't seem to capture
18 the full intent of the pending claims, and in fact, in the advisory action, the
19 examiner notes that, as currently presented, the claims do not positively
20 require that the crushed green body of which we're speaking is necessarily a
21 crushed undried green body.

22 That position now, interestingly enough, has been reversed in
23 the examiner's answer, where the examiner now concedes, unfortunately,
24 almost as an afterthought, that yes, we now recognize -- in fact, on page 17
25 of the examiner's answer, it says that applicant's argument in this regard is
26 now persuasive. The examiner agrees that the limitation in the claims is

1 sufficiently clear and that the crushed green body is clearly a crushed
2 undried green body.

3 The difficulty is that the Asami reference, the principle
4 reference here, discusses it at 23 different places in the disclosure, and then
5 specifically recites in the claims combining undried materials, the undried
6 reclaimed materials with the powdery green materials in order to find the
7 combinations that they set forth.

8 It talks about dried, unfired scrap in, like I said, 23 different
9 places, and it also -- it also claims that.

10 Now, in one embodiment that's discussed at column 8, there is a
11 discussion whereby, in an effort to reduce mechanical impacts as you're
12 coming up with that material, that reclaimed material, you may choose to
13 wet it into a slurry like composition and then to strain it, and then you get
14 this strained material.

15 The examination process, to this point, had told us that, well,
16 that says that it can be wet. That, unfortunately, ignores a couple of
17 fundamental positions taken, in our opinion, by the Asami reference, and
18 that is, first, it talks about dry, unfired scrap throughout.

19 This specific embodiment, then, is only discussed in one of the
20 ensuing eight examples, where that recovered slurry is then 100-percent
21 turned into the new process, turned into the new basis. It's not re-mixed, for
22 instance, with any dried material that may come up with these -- this clay
23 clumps.

24 All of the mixing that is talked about in the ensuing examples in
25 the Asami reference have to do with mixing this dried material of example 1
26 with other combinations of fresh green material.

1 So, the conclusion that the -- that has been made throughout
2 prosecution that, well, even though Asami is directed to dry on dry, it could
3 be expanded to be re-mixing undried back with dried.

4 We've tried to argue prior, and I'm trying to -- and I am arguing
5 today, that the difficulty with that conclusion is that it overlooks the problem
6 that has been found in the prior art, and that is, when you mix this undried
7 material with the dried material, then it forms these fist-like clumps, and one
8 of ordinary skill in the art, therefore, would not have been -- it would not
9 have been predictable to combine the Asami disclosure of dry and dry with
10 the Japanese reference, which we're just given a very partial English
11 language translation of a method for molding a wet pottery raw material
12 with -- pottery raw material having a moderate amount of water is extrusion
13 formed, and then skipping down to "wherein a part of the ceramic material
14 extruded by the kneading machine or the vacuum extruding process is
15 returned back."

16 So, what the Japanese reference teaches us is mix wet with wet.
17 What Asami teaches us is mix dry with dry.

18 What my client has found is that any attempt to mix undried, as
19 is discussed in paragraph 6 of our disclosure -- to mix undried material with
20 powdery green material, you end up with these fist-like clumps.

21 It's the eradication of those, it's the fixing of that problem that
22 the specific features recited in our pending claims, including the necessary
23 combination of the slow and fast auger-type, hoe-like mixer/kneader
24 and -- and the blade-like breaker are all necessary elements to that.

25 Again, interestingly, throughout prosecution, the examiner has
26 asserted that he takes official notice of the fact that there are kneaders and

1 breakers and so on out there in the industry that could be used to render
2 obvious the subject matter of the pending claims.

3 Only in the examiner's answer now is it specifically highlighted
4 that, okay, Brown, the Brown reference, is a specific example of one of these
5 that could be used, and yet, we sort of -- again, there hasn't been shown any
6 reasonable predictability to necessarily making that combination except as
7 you just sort of try to piece these together without (a) overlooking the
8 positive disclosures of Asami, (b) stretching the single embodiment of
9 Asami a little bit farther than it probably should be, and then combining it
10 with a wet-to-wet ceramic type molding process that's in the Japanese
11 reference, and then adding on the Brown reference sort of -- sort of for good
12 measure.

13 We are directed to a very specific problem. Our claims are very
14 specific in their recitation of what are the necessary minimal elements in
15 order to meet the claimed process, and we just don't believe that the
16 obviousness of these claims have been shown over this combination of
17 applied references.

18 Subject to any questions, that's my presentation, Your Honor.

19 JUDGE DELMENDO: So, the single -- do you deny that they
20 teach mixing it with fresh raw material?

21 MR. TANNER: Deny?

22 JUDGE DELMENDO: Yes.

23 MR. TANNER: There's no positive recitation --

24 JUDGE DELMENDO: Well, what they're teaching here about
25 the -- cordierite -- and then, in the next paragraph, it says that the process

1 reclaims cordierite composition if used alone as a starting material for
2 producing a cordierite ceramic body.

3 Alternatively, the reclaimed cordierite composition is mixed
4 with a fresh -- of cordierite composition.

5 MR. TANNER: There's no suggestion, Your Honor, that it
6 remains wet when it's mixed. I think that that's a leap that can't be made
7 here, and the basis upon which the rejection was formulated was that -- that
8 it -- that the positive disclosures of these references removes a process step,
9 and that is the necessity of drying. I think that that stretches even this
10 disclosure from the Asami reference farther than you really can. I don't
11 think it's reasonable to conclude, with all of the assertions regarding the
12 mixture of dry material, that you necessarily get to a conclusion, or even
13 impliedly get to a conclusion, where this sifted portion is not subsequently
14 dried or not necessarily subsequently dried.

15 JUDGE GARRIS: Any other questions?

16 JUDGE DELMENDO: No.

17 JUDGE GARRIS: Judge Smith?

18 JUDGE SMITH: No.

19 JUDGE GARRIS: Mr. Tanner, no further questions.

20 MR. TANNER: Thank you, Your Honor.

21 JUDGE GARRIS: Thank you very much.

22 MR. TANNER: Thank you for your time today.

23 Whereupon, at approximately 10:10 a.m., the proceedings were
24 concluded.
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